

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Hadfield, Cindy

SERIAL NO.: 10/647,849 GROUP: 3609

FILED: 08.25.2003 EXAMINER: Fields, Benjamin S

FOR: Web-Based Check Ordering System

REPLY BRIEF

Patents Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.41(a)(1), this brief is filed within two months of the Examiner's Answer filed in this case on November 25, 2008.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37(c) and M.P.E.P. § 1208:

- I. Status of Claims
- II. Grounds of Rejection to be Reviewed on Appeal
- III. Argument
- I. STATUS OF CLAIMS

Claims 1-5 stand rejected.

Claims 1-5 have been finally rejected are appealed and claims 2-5 stand or fall with claim 1.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether the Examiner has established that claims 1-5 are obvious as obvious over LAM United States Publication 2003/0074315 in view of Deluxe (www.deluxe.com) under 35 U.S.C. §103(a).

III. ARGUMENT

In addition to Applicants' Appeal Brief, Applicants wish to further discuss the Examiner's assertion, in the Examiner's Answer, that Lam in view of Deluxe renders obvious the instant invention. The Examiner admits that Lam does not disclose the claimed invention and the Deluxe does not teach the claimed invention.

However, the Examiner asserts that combination of teachings does render obvious the claimed invention. The crux of the Examiner's position is that it is obvious to modify LAM with teachings of Deluxe to render the instant invention, since Deluxe provided a website which permitted users to reorder checks by either manually calling to provide information and/or provide certain information through its web site to facilitate reordering checks and that this when combined with the teachings of Lam rendered obvious the invention. The examiner states FIG. 1 of LAM teaches bank transit data and client information of the instant invention. The examiner refers to the Deluxe web site www.deluxe.com and asserts that the elements of ordering and reordering are old and techniques known and ipso facto precludes patenting of new ways of ordering/reordering.

This thinking of course leads down the path that because the elements of flying are known which all ploy the four forces of gravity, lift, thrust and drag, that no new art of flying is patentable. Of course this is not the case.

At page 6, paragraph [0061] of LAM, it states:

a certified check, as shown in FIG. 10, is printed on standard register safety check stock having control numbers for audit purposes and issued by the bank on a specifically designed secure printer. The certified check is complete with the attorney's logo, and has the bank's facsimile signature for the certification. The check may further have a payee name and, optionally, it can show the name and address of the real estate property in question.

Contrary to the examiner's position, there is no specificity to lead one skilled in the art to believe that the bank transit data disclosed or shown are that provided by the client (purchaser of new checks or check in that case). Rather, it is likely the data from the issuing bank using/issuing the certified check system as described in LAM and not necessarily the client's own bank.

Further, it is noted that at the time of the invention, Deluxe's web site did not provide a mechanism (in contrast to the invention) which enabled reordering of checks which employed an Internet-based server having a check order entry user interface remote from and in operable communication with a client computer system, wherein the Internet-based server includes software for enabling input at the interface of client data, client check number data, client bank transit number data including bank branch name, address and branch number, client bank account data, and client bank routing data at the check

order user interface and has means for transmitting the bank client bank transit number data, the client bank account data, and the client bank routing data in an encrypted manner. Nor is there in any art of record indicating the use of or combination of a bank transit number computer system remote from and in operable communication with the Internet-based server computer system having software for receiving at least the client bank transit number data, the client bank account data, and the client bank routing data from the Internet-based server and de-encrypting the client bank transit number data, the client bank account data, and the client bank routing data, and comparing at least the client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of the bank transit number computer system to verify that the client bank transit number corresponds to bank transit data in the database, and transmits to the Internet- based server verified check print data which includes the client bank transit number data, the client bank account data, and the client bank routing data and a predetermined printing orientation. The instant invention provided this in combination with the client computer system and a printing station in operable communication with the Internet-based server computer system to print checks bearing the data thereon and a blank amount field.

By so providing, the invention automated an otherwise antiquated system of ordering and reordering checks. Until that date, one could not automatically perform such an order as no vehicle existed to do so.

True, one could effect an order prior to the invention, wherein orders taken through a site were routed back through a local bank-printer association on a referral

driven basis where lead generation resulted in commission, but did not permit or provide for real competition as with the instant invention. Applicants respectfully traverse.

The whole notion that LAM provides the missing components of Deluxe or vice versa fails. LAM does no more than provide a way to have a certified check printed at a remote site. This is a one-off process and even at that employs an officer's approval (a manual process see page 3 paragraph [0036]). In short, LAM aimed at remotely printed a certified check and stops there. There is no mention in LAM of transit data. At the relevant time prior to the invention, Deluxe did not provide the missing elements of the instant invention, namely the computer based devices as claimed with means to exchange the claimed client data and bank transit data in a manner to enable remotely printing new blank checks, i.e., a series of new checks.

Printing the checks with the claimed data thereon in a predetermined orientation requires that the server computer be equipped to print the checks in a manner which renders them blank amount field and ready for use and there must be a server from which to obtain and verify the bank transit data in order to accomplish this. The cited art provides no such teaching. If a bank transit data computer system is not available for the client computer or the Internet-based server, the process of the invention cannot be performed.

Applicant respectfully submits that neither reference alone or in combination with the other teaches, suggests or discloses the invention. Lam simply discloses a system and apparatus for remotely printing certified documents. Particularly, Lam teaches a communication system for remotely and securely printing certified checks via the Internet

and includes a customer communication device operative to initiate communication with a web server which is in communication with a system bank capable of creating an image file of the certified check which is securely encrypted and transmitted back to the customer via the Internet. Lam prints a “certified check” from a bank at a site remote to the bank wherein the remote site must have respective printing apparatus 15 (FIGS. 2 and 3) capable of printing certified documents. An encrypted image file of the requested certified check will be received at the customer location and printed using bank specified printer on pre-numbered check paper, which is issued by the bank and securely stored in the printer. This in no way teaches the claimed invention.

Also, the cited screenshot of Deluxe appears to teach no more than what was known prior to the claimed invention. That is, Deluxe, provides a site to facilitate the order of checks by partnered relationships with financial institutions. This is similar to a middle man operation wherein local printers are affiliated with the banks and perform the printing of checks for a particular bank and the web site appears to do no more than facilitating this.

Notably missing from the cited reference(s) is any teaching, disclosure or suggestion of the ability for obtaining local bank information, address, branch number in addition to the other bank and client information. Also missing is the element of the instant invention which compares at least the client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of the bank transit number computer system to verify that the client bank transit number corresponds to bank transit data in the database (i.e., the database being federally

provided). This information is required in the instant invention in order to perform a validation and goes to the heart of the instant invention. By so providing, there is not only a reduced chance of misinformation but also a mechanism in which to more securely and accurately speed the process of check ordering and reordering. Further, there is provided a mechanism by which to reduce printing costs through reduced printing error and increased competition local printers. Currently, local banks have established relationships with a printer and govern the cost of check book reorders through these relatively noncompetitive relationships.

It is respectfully submitted that the cited art, namely, Lam and Deluxe, do not render obvious the instant invention, to produce the claimed present invention. Combining Lam with Deluxe's teachings is not intuitive nor does it make sense or render the present invention as it is not understood why one would combine such teachings as they perform completely different tasks, i.e., Lam to send a single certified check to conduct a transaction such as a purchasing real estate verses Deluxe as a facilitator to reordering checks through the person's bank.

The differences between the prior art and claimed invention are very apparent. The level of ordinary skill in the art in the field of check book fulfillment has not been established and cannot be asserted without some reasonable basis for doing so. Claims 1-5 are respectfully submitted to be patentably distinct over the cited art.

In view of the above discussion, it is clear that the cited reference fails to teach or suggest the features recited in the claims. For these reasons, the withdrawal of the rejections of claims 1-5 is respectfully requested and allowance of the remaining claims is

requested. This is intended to be a timely filed reply as the date fell due on a weekend.

Dated: 1/26/2009

Respectfully submitted,

/R. William Graham/

R. William Graham

Reg. No. 33,891

Certificate of transmission

I hereby certify that this Reply Appeal Brief is being electronically filed with the Commissioner of Patent and Trademarks, Washington, D.C. 20231 on the date shown below.

Date. January 26, 2009

/ R. William Graham/